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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 09/890,164
Filing Date: July 25, 2001

PCT No.: PCT/US00/01609
International Filing Date: January 24, 2000

Applicants: Stephen C. Dassoulas et al

PCT Legal Office
PCT Petitions Attorney: Richard M. Ross

Title: Saw Blade For Cutting Fiber Cement

Attorney Docket: 0275Y-000312/USB

Commissioner of Patents and Trademarks
Washington, D.C. 20231

RESPONSE

Sir:

This communication is being submitted in response to the communication received from the United States Patent and Trademark Office dated December 24, 2002, refusing the submission under 37 C.F.R. 1.42. In particular, the declaration submitted on behalf of the deceased co-inventor has been refused because "it does not include the citizenship, mailing address, and residence information for the deceased inventor." Reconsideration of this refusal and acceptance of the submission is respectfully solicited.

The submission under 37 C.F.R. 1.42 made on August 1, 2002 is believed to be proper for both of the reasons set forth below.

1. Pursuant to 37 C.F.R. 1.63(c)(1) the mailing address and residence information is not required in a declaration if the information is supplied on an application data sheet. In the present case, an application data sheet setting forth the name, residence, mailing address and citizenship of each inventor in accordance with 37 C.F.R. 1.76(b)(1) was properly submitted. Accordingly, the noted information was not required on the declaration submitted under 37 C.F.R. 1.42.

2. 37 C.F.R. 1.63(a) provides that an oath or declaration must:

- "(1) Be executed, ...
- (2) Identify each inventor ...
- (3) Identify the country of citizenship of each inventor; and
- (4) State that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought." (emphasis added)

In addition, 37 C.F.R. 1.63(b) provides that the oath or declaration must also:

- "(1) Identify the application to which it is directed;
- (2) State that the person making the oath or declaration has reviewed and understands the contents of the application, including the claims, as amended by any amendment specifically referred to in the oath or declaration; and
- (3) State that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability s defined in §1.56." (emphasis added)

Thus, the rule expressly provides that certain information is to be identified and that certain facts are to be stated.

37 C.F.R. 1.64(b) provides that where the oath or declaration is made by a person who is not the inventor, the oath or declaration shall state the relationship of the person to the inventor, and "upon information and belief, the facts which the inventor is required to state." (emphasis added) Thus, the facts which must be recited "upon information and belief" in the oath or declaration by a legal representative of a deceased inventor under Rule 64(b) are the facts which must be stated by an inventor under Rule 63(a)(4) and Rule 63(b)(2) and (3). This distinction in Rule 64(b) between the information to be identified in an oath or declaration and the facts to be stated by an inventor under Rule 63 is rational because the facts required to be stated under Rule 63(a)(4) and 63(b)(2) and (3) could only be known "upon information and belief" by a legal representative of a deceased inventor. Therefore, as long as each inventor, his residence, mailing address and citizenship are "identified" in at least one of the submitted declarations or in an application data sheet, (as is the case in the present application), the requirements of Rule 1.63 are satisfied.

Accordingly, it is respectfully submitted that the interpretation of Rule 64(b) (and corresponding Rule 497(b)(2) for PCT applications) to require that the legal representative of a deceased inventor declare the citizenship, mailing address, and residence information for the deceased inventor, is incorrect. Favorable reconsideration is respectfully solicited.

Respectfully submitted,

By: 
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Dated: February 20, 2003

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Please type a plus sign (+) inside this box → +

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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

Application Number	09/890,164
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First Named Inventor	Stephen C. Dassoulas et al
Group Art Unit	
Examiner Name	Richard M. Ross
Attorney Docket Number	0275Y-00312USB

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ENCLOSURES (check all that apply)

<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Assignment Papers (for an Application)	<input type="checkbox"/> After Allowance Communication to Group
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input checked="" type="checkbox"/> Amendment / Response	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): return receipt postcard
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Terminal Disclaimer	
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> Request for Refund	
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> CD, Number of CD(s) _____	
<input type="checkbox"/> Response to Missing Parts/ Incomplete Application	Remarks	The Commissioner is hereby authorized to charge any additional fees that may be required under 37 CFR 1.16 or 1.17 to Deposit Account No. 02-2548. A duplicate copy of this sheet is enclosed.
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Harness, Dickey & Pierce, P.L.C.	Attorney Name Christopher M. Brock	Reg. No. 27313
Signature			
Date	February 20, 2003		

CERTIFICATE OF MAILING/TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, or facsimile transmitted to the U.S. Patent and Trademark Office on the date indicated below.

Typed or printed name	Christopher M. Brock	Date	February 20, 2003
Signature			